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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/801,236 | 03/07/2001 | William L. Reber | MNE00590 | 5423 |
| 22917 | 7590 | 09/22/2004 | EXAMINER | |
| MOTOROLA, INC. 1303 EAST ALGONQUIN ROAD IL01/3RD SCHAUMBURG, IL 60196 | | | LASTRA, DANIEL | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3622 | |

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/801,236

Applicant(s)

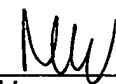
REBER ET AL.

Examiner

DANIEL LASTRA

Art Unit

3622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-20 have been examined. Application 09/801,236 (METHOD AND SYSTEM FOR PROVIDING PURCHASE REFERRALS USING MACHINE-READABLE CODES) has a filing date 03/07/2001 and Assignor: Reber, William L. and Assignee: Motorola, Inc.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-11, 17 and 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-11, 17 and 18 are not within the technological arts.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of

whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within

the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, independent claims 1, 5, 9 and 17 recite a “useful, concrete and tangible result” (a referral system), however the claims recite no structural limitations (i.e., computer implementation), and so they fail the first prong of the test (technological arts). Dependent claims 2-4, 6-8, 10-11 and 18 do not remedy this situation as no structural limitations are recited.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Ritz (US 2002/0019784).

As per claim 1, Ritz teaches:

An article comprising:

an object (see page 1, paragraph 6) ; and

a first bar code supported by the object, the first bar code identifying a first computer network destination at which a first item is offered for sale, the first bar code further identifying an associate who is to be compensated for a sale of the first item made via the first computer network destination using the first bar code (see page 8, paragraph 85).

As per claim 2, Ritz teaches:

The article of claim 1 further comprising:

a second bar code supported by the object, the second bar code identifying a second computer network destination at which a second item is offered for sale, the second bar code further identifying the associate who is to be compensated for a sale of the second item made via the second computer network destination using the second bar code (see page 8, paragraph 83).

As per claim 3, Ritz teaches:

The article of claim 2 wherein the first computer network destination is associated with a first online retailer, and the second computer network destination is associated with a second online retailer which differs from the first online retailer (see page 8, paragraph 80).

As per claim 4, Ritz teaches:

The article of claim 1 wherein the object comprises a sheet of a print medium which supports the first bar code (see page 1, paragraph 6).

As per claim 5, Ritz teaches:

A method comprising:

publishing a printed document having a first bar code which identifies a first computer network destination at which a first item is offered for sale, the first bar code further identifying an associate of a referral program; and

receiving, by the associate, compensation for a sale of the first item made via the first computer network destination using the first bar code. Claim 5 contains the same limitations as claim 1 therefore the same rejection is applied.

As per claim 6, Ritz teaches:

The method of claim 5 wherein the printed document has a second bar code which identifies a second computer network destination at which a second item is offered for sale, the second bar code further identifying the associate of the referral program. Claim 6 contains the same limitations as claim 2 therefore the same rejection is applied.

As per claim 7, Ritz teaches:

The method of claim 6 further comprising receiving, by the associate, compensation for a sale of the second item made via the second computer network destination using the second bar code. Claim 7 contains the same limitations as claim 2 therefore the same rejection is applied.

As per claim 8, Ritz teaches:

The method of claim 7 wherein the first computer network destination is associated with a first online retailer, and the second computer network destination is associated with a second online retailer which differs from the first online retailer. Claim 8 contains the same limitations as claim 3 therefore the same rejection is applied.

As per claim 9, Ritz teaches:

An apparatus comprising:

a document processor to publish a printed document having a first bar code which identifies a first computer network destination at which a first item is offered for sale, the first bar code further identifying an associate of a referral program. Claim 9 contains the same limitations as claim 1 therefore the same rejection is applied.

As per claim 10, Ritz teaches:

The apparatus of claim 9 wherein the document processor is to publish the printed document with a second bar code which identifies a second computer network destination at which a second item is offered for sale, the second bar code further identifying the associate of the referral program. Claim 10 contains the same limitations as claim 2 therefore the same rejection is applied.

As per claim 11, Ritz teaches:

The apparatus of claim 10 wherein the first computer network destination is associated with a first online retailer, and the second computer network destination is associated with a second online retailer which differs from the first online retailer. Claim 11 contains the same limitations as claim 3 therefore the same rejection is applied.

As per claim 12, Ritz teaches:

A computer-readable medium having computer-readable content to direct a processor to publish a printed document having a first bar code which identifies a first computer network destination at which a first item is offered for sale, the first bar code further identifying an associate of a referral program. Claim 12 contains the same limitations as claim 1 therefore the same rejection is applied.

As per claim 13, Ritz teaches:

The computer-readable medium of claim 12 wherein the computer-readable content further directs the processor to publish the printed document with a second bar code which identifies a second computer network destination at which a second item is offered for sale, the second bar code further identifying the associate of the referral program. Claim 13 contains the same limitations as claim 2 therefore the same rejection is applied.

As per claim 14, Ritz teaches:

The computer-readable medium of claim 13 wherein the first computer network destination is associated with a first online retailer, and the second computer network destination is associated with a second online retailer which differs from the first online retailer. Claim 14 contains the same limitations as claim 3 therefore the same rejection is applied.

As per claim 15, Ritz teaches:

A kit comprising:

a print medium, and

a computer-readable medium having computer-readable content to direct a printer to print onto the print medium a first bar code which identifies a first computer network destination at which a first item is offered for sale, the first bar code further identifying an associate of a referral program. Claim 15 contains the same limitations as claim 1 therefore the same rejection is applied.

As per claim 16, Ritz teaches:

The kit of claim 15 the computer-readable content further directs the printer to print onto the print medium a second bar code which identifies a second computer network destination at which a second item is offered for sale, the second bar code further identifying the associate of the referral program. Claim 16 contains the same limitations as claim 2 therefore the same rejection is applied.

As per claim 17, Ritz teaches:

A method comprising:

transacting a sale of an item made via a computer network destination using a bar code, the bar code identifying the computer network destination at which the item is offered for sale, the bar code further identifying an associate of a referral program; and

compensating the associate based on the sale. Claim 17 contains the same limitations as claim 1 therefore the same rejection is applied.

As per claim 18, Ritz teaches:

The method of claim 17 further comprising:

receiving a request message which contains a first identifier of the item and a second identifier of the associate, wherein the first identifier and the second identifier are encoded by the bar code;

wherein said transacting the sale is based on the request message. Claim 18 contains the same limitations as claim 1 therefore the same rejection is applied.

As per claim 19, Ritz teaches:

A system comprising:

a server system at a computer network destination identified by a bar code which further identifies an associate of a referral program, the server system to offer an item for sale via the computer network, to transact a sale of the item via the computer network, and to compensate the associate based on the sale. Claim 19 contains the same limitations as claim 1 therefore the same rejection is applied.

As per claim 20, Ritz teaches:

The system of claim 19 wherein the server system is to receive a request message which contains a first identifier of the item and a second identifier of the associate, wherein the first identifier and the second identifier are encoded by the bar code, and wherein the server system is to transact the sale based on the request message. Claim 20 contains the same limitations as claim 1 therefore the same rejection is applied.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Dougherty teaches a printable interface and digital linkmarks.

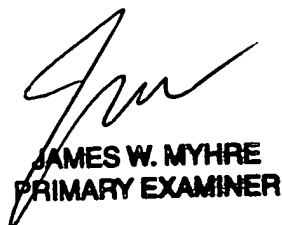
Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel Lastra
August 30, 2004



JAMES W. MYHRE
PRIMARY EXAMINER